

GOOGLE LLC,

Plaintiff,

No. C 20-06754 WHA

V.

SONOS, INC.,

ORDER RE MOTION TO STRIKE

Defendant.

INTRODUCTION

In this patent infringement action, patent owner asserts that alleged infringer has violated this district's Patent Local Rules by incorporating references and theories in its summary judgment filings and corresponding expert report not disclosed in its invalidity contentions. To the following extent, patent owner's motion to strike is **GRANTED IN PART** and **DENIED IN PART**.

STATEMENT

The facts in this matter are well known and described previously (No. C 21-07559 WHA, Dkt. No. 156). Patent owner Sonos, Inc. asserts that Google LLC infringes U.S. Patent Nos. 9,967,615; 10,469,966; 10,779,033; and 10,848,885. The patents generally concern multi-room “smart” speaker technology. This motion practice takes place in the context of Google’s declaratory judgment action.

1 Relevant here, an October 2021 order scheduled a “patent showdown” procedure, wherein
2 each side moves for summary judgment on one particular claim-in-suit. The parties have now
3 filed their briefing for the patent showdown, supported by expert declarations. Sonos now
4 moves to strike the following from Google’s motion for summary judgment of noninfringement
5 or invalidity of the ’615 patent for improperly asserting new invalidity arguments and prior art
6 references:

- 7 1. Page 19, lines 1–7; page 20, lines 3–6, 11–14 from Google’s motion for summary
8 judgment;
- 9 2. Paragraphs 133–34, 136–37, 139–41, 143–45, 149, 158–60, 169–71, 180, and 182
10 from the supporting expert report of Dr. Samrat Bhattacharjee;
- 11 3. Exhibits 10 and 14 to Google’s motion for summary judgment.

12 This order follows full briefing and oral argument.

13 ANALYSIS

14 Our patent local rules streamline discovery and seek to quickly uncover the primary
15 disputes in the action. They require the parties to disclose their infringement and invalidity
16 contentions early, but permit amendment as new information comes to light in discovery. *O2*
17 *Micro Int’l Ltd. v. Monolithic Pwr. Sys., Inc.*, 467 F.3d 1355, 1365–66 (Fed. Cir. 2006).
18 Pursuant to Patent Local Rule 3, a party may not use an expert report or motion memoranda “to
19 introduce new infringement theories, new infringing instrumentalities, new invalidity theories,
20 or new prior art references not disclosed in the parties’ infringement contentions or invalidity
21 contentions.” *See ASUS Computer Int’l v. Round Rock Research, LLC*, 2014 WL 1463609, at
22 *1 (N.D. Cal. Apr. 11, 2014) (Judge Nathaniel M. Cousins). Such an infraction may be subject
23 to a motion to strike, but the rules do “not require identification of every evidentiary *item of*
24 *proof.*” *See Oracle Am., Inc. v. Google Inc.*, 2011 WL 4479305, at *3 (N.D. Cal. Sept. 26,
25 2011).

26 This order considers each issue flagged by Sonos in turn.

27 1. ANTICIPATION THEORY FOR LIMITATION 13.4.

1 Claim limitation 13.4 of the '615 patent recites: "detecting a set of inputs to transfer
 2 playback from the control device to a particular playback device, wherein the set of inputs
 3 comprises: (i) a selection of the selectable option for transferring playback from the control
 4 device and (ii) a selection of the particular playback device from the identified playback devices
 5 connected to the local area network." Sonos argues that Google asserts a new anticipation
 6 theory for the limitation that it did not include in its contentions. Specifically, while the
 7 contentions only identified a "Connect" button as teaching limitation 13.4, the motion "changes
 8 its theory by now pointing to a never-before identified 'menu' button and claims that section of
 9 *that* button in combination with selection of the 'Connect' button disclose this claim element"
 10 (Br. 4). Here is the side-by-side Sonos used in its motion (Br. 5):

Invalidity Contentions	Summary Judgment
<p>12 "The YT Remote System implicitly detects a 13 set of inputs once the '<i>connect</i>' option is 14 selected, based on devices on the same LAN 15 for which user is logged in, e.g. a TV screen 16 logged into the user's YouTube account. 17 18 <i>See e.g. [4]</i></p>  <p>19 20 21 22 23 Set of inputs detected 24 25 Ex. A ('615 Chart) at 18 (emphasis in text 26 added). 27 28</p>	<p>12 "To transfer playback using the YTR 13 application the user may press the <i>menu</i> button 14 (shown in green in the image ...) which brings 15 up a '<i>Connect</i>' button (shown in red) that the 16 user may further select to transfer playback to a 17 particular playback device. The user's 18 selection of <i>menu</i> and <i>select</i> [sic] are a 'set of 19 inputs' to transfer playback that are detected by 20 the Android phone. 21 22 23 24 25 Google's MSJ at 19 (emphasis in text added). 26 27 28</p>

Google argues that "Sonos has been on notice that selection of the Connect icon requires a user to press menu in order to bring up the Connect icon" and notes that the menu button is

1 visible in both screenshots Sonos compares (Opp. 10–11). More importantly, item [4] — cited
2 in the contentions and where the relevant image originated — specifically states that a user must
3 “press menu and connect” (Contentions at 18, Cardis Decl. Exh. A).¹

4 Upon review, this order declines to strike Google’s statements here. The material at issue
5 does not qualify as a new anticipation theory. Rather, Google has spelled out what its invalidity
6 contentions recite. A party may not conceal its theories from disclosure in its contentions, but a
7 party need not compose its dispositive briefing in its contentions, either. The decision in
8 *Largan Precision Co., Ltd. v. Genius Electronic Optical Co.*, 2014 WL 6882275 (N.D. Cal.
9 Dec. 5, 2014) (Judge James Donato), does not support striking this material. *Largan* struck
10 portions of an expert report that used uncited portions of a prior art reference (a patent) because
11 none of the references to the patent in the party’s contentions disclosed the theory being
12 asserted by the expert. *Id.* at *5. Sonos contends “[p]ointing to a new portion of a reference is
13 not ‘additional explanation’ of a previously-disclosed theory, it is a *new theory*” (Reply Br. 5).
14 But that is not quite the same thing. Google’s anticipation theory on this point has remained
15 consistent. Recognizing Sonos’s concerns, on balance, this order finds fairness best served by
16 denying the motion to strike as to this material and addressing these issues on the merits.

17 **2. OBVIOUSNESS THEORY FOR LIMITATION 13.4.**

18 The answer is the same for Google’s obviousness theory for claim limitation 13.4.
19 Google argues in its summary judgment motion that the limitation is obvious in part because
20 U.S. Patent No. 9,490,998 discloses that “the ‘user interface’ of the Remote Control may
21 display the ‘previously paired controlled devices’ so that a user may select and control ‘one or
22 more paired controlled devices’” (Dkt. No. 221 at 20, citing ’998 patent at 10:62–11:6). Sonos
23 objects that Google never cited to this specific disclosure in its invalidity contentions. Google
24 did, however, disclose that it was relying on this reference to meet limitation 13.4 (Contentions
25 at 18–20, citing 4:21–57, 4:48–67, 8:1–59, and figure 1). Each of these citations generally
26 disclose various ways a remote control may be paired with controlled devices (Opp. 13). The

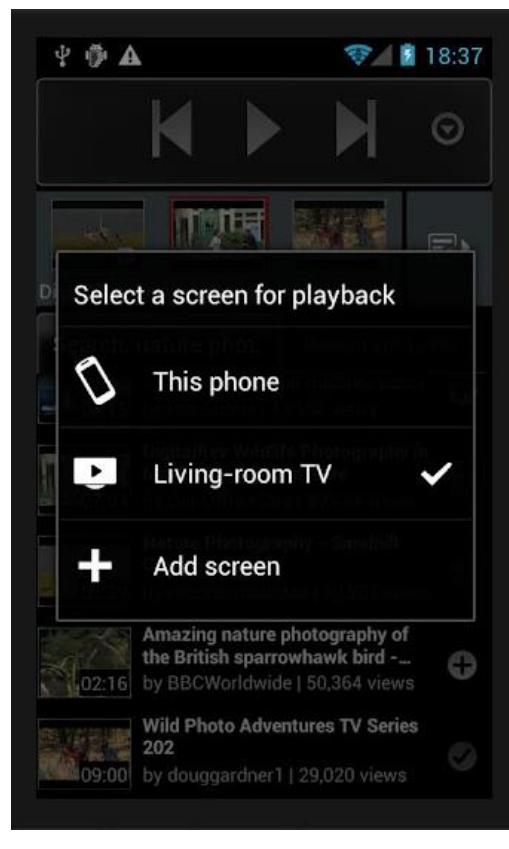
27
28 ¹ Citing <https://www.youtube.com/watch?v=EGdsOslqG2s> at 0:53–1:09 (last visited May 18, 2022).

1 citation to 10:62–11:6 accordingly qualifies as permissible additional evidentiary support rather
2 a new theory.

3 **3. FEBRUARY 2012 YOUTUBE REMOTE WAYBACK MACHINE
4 CAPTURE.**

5 Next, we consider exhibit 14 — a Wayback Machine capture dated February 29, 2012, of
6 a website purportedly depicting a version of the YouTube Remote system from January 25,
7 2012 (Dkt. No. 211-14). Sonos argues Google never disclosed this version of the system and
8 that “[i]nstead, in its contentions, Google specifically cited to an October 14, 2011 Wayback
9 Machine capture showing an *earlier*, different version of the YouTube Remote System” (Br. 8).

10 Google explains that its invalidity contentions do not constitute a prior art document, and
11 that the webpage capture in question illustrates the description of the prior art in the
12 contentions:

Google's Infringement Contentions (Contentions at 18)	Wayback Machine Capture (Dkt. No. 211-14)
<p>14 The YT Remote System implicitly detects a 15 set of inputs once the “connect” option is 16 selected, based on devices on the same LAN 17 for which user is logged in, e.g. a TV screen 18 logged into the user’s YouTube account.</p>	

1 Sonos argues “the original 2011 capture and corresponding narrative explanation do not portray
2 a display that allows a user to *select* and control a *particular* paired controlled device” (Reply
3 Br. 9). But, as shown, Google stated in its contentions that the YouTube remote system can
4 detect a set of inputs based on devices on the same LAN for which the user is logged in, such as
5 a television. Google’s summary judgment motion merely visually depicts that capability. The
6 capture, consequently, does not constitute a new theory or prior art reference but further
7 evidentiary support.

8 Sonos also notes how Google did not produce exhibit 14 (and exhibit 10 discussed below)
9 until it filed its motion for summary judgment (Reply Br. 10). This order finds this apparent
10 delay concerning as it suggests a measure of gamesmanship the patent local rules seek to stamp
11 out. Nevertheless, our patent showdown procedure requires the parties to move expeditiously
12 towards a merits determination while fact discovery is ongoing. This inherently entails the
13 possibility that a given document may be produced contemporaneously with a party’s summary
14 judgment motion. Without further indications of an improper motive, and so long as the party’s
15 contentions disclose the theory and/or prior art reference per Patent Local Rule 3, a production
16 such as this does not cross the line. The opposing party will also have adequate opportunity to
17 address those documents in its opposition. Sonos has not demonstrated Google’s actions here
18 require this order to take action based on a marginally dilatory document production.

19 Sonos’s motion to strike as to this capture is denied.

20 **4. JULY 2010 YOUTUBE REMOTE API DOCUMENTATION.**

21 We turn to exhibit 10 to Google’s motion for summary judgment. This three-page
22 document describes the API for the first release of the YouTube remote application, which used
23 version 1 of Google’s MDx protocol (Exh. 10, Dkt. No. 211-10). Sonos argues “Google’s
24 invalidity contentions for the ’615 patent do not include references to exhibit 10 or any other
25 API or API documentation” (Br. 10). Further, Sonos explains that exhibit 10 “is Dr.
26 Bhattacharjee’s sole support that the ‘prior art’ YouTube Remote System is allegedly similar to
27 the *accused* YouTube application” (*ibid.*).

1 Upon review of his declaration, Dr. Bhattacharjee refers to exhibit 10 to describe how the
2 YouTube Remote application would send a “setPlaylist” message to a MDx server that would in
3 turn send the message to, *e.g.*, a television to resume playback, as well as how that functionality
4 purportedly qualifies as a “local playback queue” as recited by the ’615 patent (Bhattacharjee
5 Decl. ¶¶ 137, 180, Dkt. No. 211-1). The exhibit contains the same key information regarding
6 the “setPlaylist” message disclosed in Google contentions by item [7], documentation
7 describing the YouTube remote system’s MDx protocol (*compare* Exh. 10, *with* Contentions at
8 1, 24–25). Google’s use of a different document to support a theory it disclosed in its
9 contentions does not run afoul of our Patent Local Rules. Sonos has also not sufficiently
10 explained why a document describing the YouTube remote application’s API constitute a prior
11 art reference distinct from the YouTube remote application, generally. Further, as discussed
12 above, Google’s production of this document contemporaneously with its motion for summary
13 judgment does not change this conclusion.

14 Sonos’s motion to strike as to exhibit 10 is denied.

15 **5. “REPRODUCED” JULY 2011 SOURCE CODE.**

16 Next up is source code for the YouTube Remote application dated July 12, 2011. As
17 Google explains, it produced this code in tandem with its updated invalidity contentions that it
18 served on December 7, 2021 (Opp. 19). In a supplemental interrogatory response dated
19 February 4, 2022, Sonos challenged the prior-art status of the YouTube remote system. In
20 Google’s words: “To address Sonos’s newly-raised objection, Google re-collected and
21 reproduced [on March 22] the YouTube Remote source code from July 12, 2011 in a manner
22 that preserved the last modified dates of each file” (*ibid.*).

23 Sonos, suspicious of Google’s production, notes that the declaration describing the
24 reproduction “does not say that the contents of the files from each of these versions are identical
25 or if they contain additional lines of code or changed lines” (Reply Br. 11). But neither does
26 Sonos identify a single change it discovered beyond the last-modified date. Ultimately, without
27 more, this order cannot justify the serious remedy of striking the material related to the July
28 2011 source code.

1 **6. NOVEMBER 2010 SOURCE CODE.**

2 When Google “reproduced” its July 2011 source code in March 2022, it also produced for
3 the first time source code from November 11, 2010 for its YouTube Remote system. Google
4 explains that this November 2010 source code “show[ed] that the YT remote system was prior
5 art not only as of July 2011, but also much earlier” (Reply Br. 19). It claims the earlier source
6 code “just adds additional support that the functionality Google relies on also existed at least as
7 early as November 11, 2010 (*id.* at 19). Sonos correctly notes, however, that “Google offers no
8 explanation as to why this code was not produced with (or even referenced in) its contentions”
9 (Reply Br. 12).

10 Source code is rarely static. Whether a different iteration of the code also required
11 disclosure can depend on the degree in which the undisclosed version differs from the disclosed
12 version. Minor differences do not constitute a new prior art reference or theory and would
13 merely provide further evidentiary support, which does not justify striking the material.
14 Substantive differences that bear on a particular claim limitation, however, are different. *See*
15 *Oracle*, 2011 WL 4479305, at *3–4. Dr. Bhattacharjee’s declaration reveals negligible
16 differences between the November 2010 and July 2011 source code for some features of the
17 YouTube remote system, such as a revised name for a particular variable when the system pairs
18 the YouTube remote application with the backend server (*compare* Bhattacharjee Decl. ¶ 133,
19 *with id.* at ¶ 134). For other features, however, the differences are more significant. Take, for
20 example, how the system transfers playback of a playlist from the application on the mobile
21 device to the “LeanBack Screen,” *i.e.*, the user’s television. For that feature, Dr.
22 Bhattacharjee’s description reveals stark differences between the November 2010 and July 2011
23 source code, both of which Google seeks to map onto claim limitations 13.5 and 13.6 of the
24 ’615 patent. Upon review, the different iterations of the YouTube remote source code that
25 Google cites may both carry out similar features, but they do so in very different ways (*see*
26 Bhattacharjee Decl. ¶ 139, 143). The July 2011 code has different variables and new functions.
27 This order finds that such differences required disclosure in Google’s contentions.

1 Google justifies its inclusion of the new version of the source code on the grounds that
2 Sonos moved the priority date of its patents from December 30, 2011 to July 15, 2011. That
3 could have opened the door for Google to amend its infringement contentions to include the
4 November 2010 source code. But Google made no such amendment. Such a change does not
5 allow Google to insert the November 2010 code at summary judgment as an alternative
6 argument for invalidity of the '615 patent. This order accordingly strikes paragraphs 133 and
7 138–41 of Dr. Bhattacharjee's expert report.

8 **7. PINTPOINT CITATIONS.**

9 Finally, Sonos argues that Google's invalidity contentions "merely cite to directories and
10 subdirectories of source code without identifying any specific files or pinpoint citations to
11 specific line numbers that would map those citations onto specific claim elements" (Br. 12).
12 Accordingly, Sonos requests this order strike paragraphs 133–34, 139–41, 143–45, 158, 170,
13 and 182 of Dr. Bhattacharjee's declaration.

14 Sonos primarily relies in part on *MasterObjects, Inc. v. Amazon.com, Inc.*, No. C 20-
15 08103 WHA, 2021 WL 5987101 (N.D. Cal. Dec. 17, 2021). That order, however, did not find
16 that pinpoint citations for source code were always required. Rather, it noted that some
17 decisions from our district have reached that conclusion but reasoned that, even if not *per se*
18 required, those citations were required in that action in light of counsel's previous statements on
19 the matter. As previous decisions have made clear, pinpoint citations to source code may not
20 always be required. *See Oracle*, 2011 WL 4479305, at *3.

21 More fundamentally, the problem with Sonos's motion lies in the fact that it had notice
22 that Google did not plan to amend its contentions on this point as of March 2 (Cardis Decl.
23 Exhs. C, D). Sonos then strategically chose not to initiate motion practice on this issue until
24 April 21, fifty days after Google's March 2 letter. And that motion practice did not target
25 Google's invalidity contentions but Google's summary judgment motion. If Sonos felt pinpoint
26 citations were required in this matter, it "should have sought intervention from the Court,
27 instead of moving to strike [Google's] expert report after the fact." *Largan*, 2014 WL 6882275,
28 at *7. The motion to strike this material is denied.

CONCLUSION

For the foregoing reasons, the motion to strike is **GRANTED IN PART** and **DENIED IN PART**. This order strikes paragraphs 133 and 138–41 of Dr. Bhattacharjee’s expert report in their entirety. The rest of the motion is denied.

IT IS SO ORDERED.

Dated: August 2, 2022.

W^m Alsup
WILLIAM ALSUP
UNITED STATES DISTRICT JUDGE

United States District Court
Northern District of California